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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,863	09/09/2003	Mark L. Yoseloff	PA0906.ap.US	5188

7590 08/16/2005

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EXAMINER
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LAYNO, BENJAMIN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/658,863

Applicant(s)

YOSELOFF ET AL.

Examiner

Benjamin H. Layno

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant has **not** complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application 10/658,863 must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application), 08/504,023, now Patent No. 5,685,774; the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

In the Applicant's amendment filed 05/26/05, the Applicant has argued that the de Keller reference (filing date 09/11/95) is **not** available under 35 USC 102(b) as a reference in view of the priority date chain established for the present application. The Applicant provided a Table comparing claim 1 of the present invention with the disclosure of the earliest application in the priority chain 08/504,023, in order to support for the priority date of 07/19/05. Included in the Table is a recitation in claim 1 of the present invention, "providing **community cards** to complete partial hands in the first poker-type game". The Table indicated that this recitation is supported by the earliest application 08/504,023, which recites "According to each of these embodiments, the dealer is also preferably provided with the same number of standard cards and the **wild**

**card** as provided to each player". The Applicant argued that **"The single wild card to all players is a community card"**. The Examiner disagrees.

The disclosure of the present invention 10/658863 discloses the well-known game "LET IT RIDE", which uses community cards. The community cards are used by each player to form a five-card hand, page 2, lines 14-15. The present invention also recites "In the preferred game a dealer deals three player's cards face down to each player and two community cards face down to the dealer.....The dealer then turns over one of the dealer's community cards and the dealer's query is repeated.....Finally, all cards are shown and the payouts and collections are resolved....This widely played game is known as LET IT RIDE stud poker", page 5, lines 14-26. The Examiner take the position that in LET IT RIDE, the community cards each have a **specific fixed value**, what ever value is printed on a community card, that is the value that is used by all players during game play.

The disclosure of the earliest application 08/504,023, on the other hand, **does not** disclose "community cards". Instead, it discloses "wild cards". Earliest application 08/504,023 recites "In a five-card game each player and the dealer may substitute the wild card for any other card in their hand to improve the five-card hand they hold", col. 8, lines 50-53. Thus, **the values of "wild cards" vary** according to the player's desire.

Thus, the disclosure of the invention in the parent application (08/504,023, which recites "wild cards" having varying values, and does not recite "community cards" having fixed values), and in the later-filed application (10/658,863 which recites "community cards" having fixed values) are **different** and **do not** comply with the

requirements of the first paragraph of 35 U.S.C. 112, and therefore the present invention 10/658,863 **does not** receive the benefit of the filing date of the parent application 08/504,023.

***Claim Rejections - 35 USC § 102 or § 103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 6, 8-11, 15, 18-21 and 24-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over de Keller.

The Applicant is referred to the last Office action mailed 02/24/05. The Applicant has argued that “de Keller does not place initial multiple part wagers.....these multiple part wagers are placed prior to the player viewing dealt cards”. The Examiner takes the position that de Keller recites “At the start of each game and **prior to receiving cards** all players place a chip(s) in their Pots 8 and wager a chip(s) on Bet One 5”, col. 4, lines 22-24. Thus, the “wager chip(s) in Bet One 5” is an initial multiple-part wager placed prior to the player viewing dealt cards.

The Applicant has also argues "proposed new claim 26 wherein the game has been limited to play against only pay tables. This provides a clear avoidance of de Keller who has competition against a pay table and player-versus-player". The Examiner takes the position that de Keller recites that his disclosed game "Showdown Poker" can be adapted and played on a video game machine, col. 5, lines 28-29. De Keller also recites "A player, irrespective of 'standing' after the deal or after BET 1 will be paid a winning hand according to the number of coins bet....The pay-offs on video styled machine like the table game, are **based on traditional poker rankings**". Furthermore, the Examiner takes also takes the position that it is inherent and/or well known that all video poker machines are player-versus-pay tables, and not player-versus-player type games. Thus, it would have been inherent and/or obvious for de Keller's video game machine embodiment to be wagering game to be played against only pay tables.

***Claim Rejections - 35 USC § 103***

5. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller.

The Applicant is referred to the first Office action.

6. Claims 3-5, 7, 12-14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over de Keller as applied to claim 1 above, and further in view of Breeding 081'.

The Applicant is referred to the first Office action.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

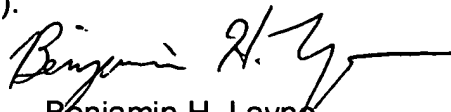
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layne  
Primary Examiner  
Art Unit 3711

bhl